UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,261	11/29/1999	RANDY P. STANLEY	ITL.0289US	7389

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EXAMINER
LIN, KENNY S

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

<table>
<tr><td rowspan="2" style="text-align:center; vertical-align:middle">

Office Action Summary</td><td colspan="2">Application No.

09/450,261</td><td colspan="2">Applicant(s)

STANLEY, RANDY P.</td></tr>
<tr><td colspan="2">Examiner

Kenny Lin</td><td>Art Unit

2152</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 August 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 are presented for examination.

2.   A decision by the Board of Patent Appeals and Interferences reversing the examiner's

answer was mailed on August 30, 2006. Accordingly, the finality of the last office action is

withdrawn. However, a new ground of rejection has been stated herein and prosecution in this

application has been reopened due to the finding of new prior art.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 8-14 are rejected under 35 U.S.C. 101 because the disclosed invention is

nonstatutory, inoperative and therefore lacks utility. An article comprising a medium for storing

instructions such as carrier wave or optical wave carrying instruction is not tangible since such

computer transport medium does not fall into the categories of "process", "machine",

"manufacture" and "composition of matter". Furthermore, the computer program stored on

carrier wave is not operable if not executed by a computer or system. Therefore, the inoperative

of the instructions stored on a computer transport medium lacks utility.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

  a. The following terms lack proper antecedence basis:

    i. Claim 1, line 3 – a storage (is this the same storage coupled to the first processor-based system or not?);

    ii. Claim 5, line 1 – a predetermined time (is this a different predetermined time from the one in claim 1?);

    iii. Claims 8-14 – a processor-based system (is this the same as a first processor-based system?);

    iv. Claim 8, line 4 – a storage (is this the same storage coupled to the first processor-based system or not?);

    v. Claim 12, line 2 – a predetermined time (is this a different predetermined time from the one in claim 8?).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1, 3-5, 7-8, 10-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Narurkar et al (hereinafter Narurkar), U.S. Patent Number 6,339,795, in view

of Deo et al (hereinafter Deo), US 6,356,956.

9.   Narurkar was cited in the previous office action.

10.   As per claims 1 and 8, Narurkar taught the invention substantially as claimed including a

method comprising automatically transferring time sensitive data (title, col.3, lines 49-55, col.5,

lines 6-9, col.9, lines 36-44: schedule, PIM, Outlook data) from a storage coupled to a first

processor-based system (col.6, lines 55-67, col.7, lines 1-10) to a storage coupled to a second

processor-base system (col.7, lines 11-23).

11.   Narurkar further taught that the time sensitive data includes PIM data and Outlook data

(col.9, lines 36-44). Narurkar did not specifically teach to automatically display time sensitive

data on a display coupled to second processor-based system at a predetermined time. Deo taught

to transfer time sensitive data from a first processor based system to a storage of a second

processor based system (col.2, lines 20-27, 55-60, col.3, lines 9-17, 61-67, col.4, lines 11-15) and

automatically display the time sensitive data on a display coupled to the second processor-based

system at a predetermined time (col.1, lines 53-58, col.2, lines 28-35, col.4, lines 11-15, 26-29,

34-38, col.5, lines 19-29). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to combine the teachings of Narurkar and Deo because Deo's

teaching of time sensitive data such as reminders and appointments to automatically display data

at predetermined time helps to remind the users of the scheduled events such as meeting or anniversaries (see Deo col.5, lines 19-29).

12.   As per claim 15, Narurkar taught the invention substantially as claimed including a processor-based system comprising, comprising a processor (28, fig.2), a first storage storing a personal information manager application (52, fig.2, col.6, lines 35-40, col.7, lines 16-18), and a second storage storing software including instructions (51, fig.2, col.7, lines 11-16) that causes the processor to automatically transfer time sensitive data to another processor-based device (title, 22, fig.2, col.3, lines 49-55, col.5, lines 6-9, col.9, lines 36-44).

Narurkar further taught that the time sensitive data includes PIM data and Outlook data (col.9, lines 36-44). Narurkar did not specifically teach to automatically display time sensitive data at a predetermined time. Deo taught to transfer time sensitive data from a first processor based system to a storage of a second processor based system (col.2, lines 20-27, 55-60, col.3, lines 9-17, 61-67, col.4, lines 11-15) and automatically display the time sensitive data on a display coupled to the second processor-based system at a predetermined time (col.1, lines 53-58, col.2, lines 28-35, col.4, lines 11-15, 26-29, 34-38, col.5, lines 19-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Narurkar and Deo because Deo's teaching of time sensitive data such as reminders and appointments to automatically display data at predetermined time helps to remind the users of the scheduled events such as meeting or anniversaries (see Deo col.5, lines 19-29).

13.   As per claims 3 and 10, Narurkar and Deo taught the invention substantially as claimed in

claims 1 and 8. Narurkar further taught to automatically transfer personal information manger

information (col.6, lines 30-40).

14.   As per claims 4 and 11, Narurkar and Deo taught the invention substantially as claimed in

claims 3 and 10. Deo further taught that automatically transferring personal information

manager information includes automatically transferring timed alerts (col.2, lines 28-35, col.4,

lines 11-15, 26-29, 34-38, col.5, lines 19-29).

15.   As per claims 5 and 12, Narurkar and Deo taught the invention substantially as claimed in

claims 1 and 8. Deo further taught that automatically providing an audible alert at a

predetermined time (col.5, lines 19-29).

16.   As per claims 7 and 14, Narurkar and Deo taught the invention substantially as claimed in

claims 1 and 8. Deo further taught to automatically display a portion of a calendar graphical user

interface (col.5, lines 19-29: data object is displayed to the user in conjunction with the

appointment).

17.   As per claim 16, Narurkar and Deo taught the invention substantially as claimed in claim

15. Narurkar further taught to include a link on system to device (26, fig.2, col.6, lines 26-29).

18.   As per claim 17, Narurkar and Deo taught the invention substantially as claimed in claim

16. Narurkar further taught that the system is a portable computer that includes device (fig.1-3,

col.6, lines 26-39).

19.   As per claim 18, Narurkar and Deo taught the invention substantially as claimed in claim

17. Narurkar further teach a housing for computer and the display of the device being located on

the outside of housing (fig.1).

20.   Claims 2, 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Narurkar and Deo, as applied to claims 1, 3-5, 7-8, 10-12 and 14-18 above, and further in view

of Kanevsky et al (hereinafter Kanevsky), U.S. Patent Number 6,496,949.

21.   Kanevsky was cited in the previous office action.

22.   As per claims 2, 9 and 20, Narurkar and Deo taught the invention substantially as claimed

in claims 1, 8 and 15 including that the time sensitive data is automatically transferred from the

storage coupled to the first processor-based system (title, col.3, lines 49-55, col.5, lines 6-9,

col.9, lines 36-44). Narurkar and Deo did not specifically teach that the time sensitive data is

automatically transferred when it is determined that the first processor-based system is being

powered off. However, it is well known in the art to save files as back ups in a remote hard drive

before a processor-based system such as a web server is shut down for repair or update.

Kanevsky taught to automatically backup the data when it is determined that the first processor-

based system is being powered off (col.1, lines 12-24). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to combine the teachings of Narurkar,

Deo and Kanevsky because Kanevsky's teaching of data backup when the first processor-based

is determined to be powered off helps to prevent the data from being lost.

23.   Claims 6, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Narurkar and Deo, as applied to claims 1, 3-5, 7-8, 10-12 and 14-18 above, and further in view

of Tsukakoshi et al (hereinafter Tsukakoshi), U.S. Patent Number 5,926,623.

24.   Tsukakoshi was cited in the previous office action.

25.   As per claims 6, 13 and 19, Narurkar and Deo taught the invention substantially as

claimed in claims 1, 8 and 15. They did not specifically teach to provide real time clock

information from first processor-based system to second processor-based system. However,

Tsukakoshi taught to provide real time clock information from first processor-based system to

second processor-based system (col.6, lines 11-18, col.10, lines 48-53). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Narurkar, Deo and Tsukakoshi because Tsukakoshi's teaching of enables the two

processor-based system to share the clock information so to provide synchronization in time for

the time sensitive data.

Conclusion

26.   A shortened statutory period for reply to this Office action is set to expire THREE

MONTHS from the mailing date of this action.

27.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The

examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number

for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
September 25, 2006

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